

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

KELLER et al.

PCT Application No. PCT/EP04/11062

PCT Filing Date: October 4, 2004

U.S. Serial No.: 10/575,019

Filed: April 6, 2006

Atty. File No.: 2584SG-5

For: "FIRE PROTECTION GATE
AND CORRELATED FIRE
PROTECTION INSET"RENEWED PETITION UNDER
37 C.F.R 1.10(d)

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
BEING DEPOSITED WITH THE UNITED STATES
POSTAL SERVICE AS FIRST CLASS MAIL IN AN
ENVELOPE ADDRESSED TO THE COMMISSIONER
FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA
22313-1450 ON March 15, 2007Sheridan Ross P.C.
Bunde CarpenterMail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

The Decision of the U.S. Patent and Trademark Office dated December 6, 2006 is noted. In the Office's opinion, the prior petition did not sufficiently establish the third criterion. To comply with the Office's request, Applicants now submit evidence in the form of: a Supplemental Declaration of Susan Willson, managing partner of foreign patent prosecution for Sheridan Ross, P.C.; a Supplemental Declaration of Eddie Abeyta; a Supplemental Declaration of Carol Werner; a Declaration of Ian Walsworth; a Notification of Missing Requirements received in PCT/EP04/11061, a similarly situated application (Exhibit A); and a copy of email correspondence between Sheridan Ross, P.C. and Grosse Bockhorni & Schumacher on the evening of April 6, 2006 (Exhibit B).

Applicants direct the Office's attention to Exhibit A. The application corresponding to this Notification, PCT/EP04/11061 ("the '061 Application"), was initially given the incorrect date-in of April 7, 2006, despite being deposited by Mr. Eddie Abeyta on April 6, 2006, and was subsequently taken up with the Office by petition. In fact, the last petition filed with the USPTO in the '061 Application, dated October 23, 2006, included nearly identical material as that submitted in the last petition filed for this application (Applicant's Second Renewed Petition mailed November 20, 2006). Undersigned counsel is pleased to acknowledge, however, that the priority date of October 6, 2003 is correctly reflected in the '061 Application, and prosecution is advancing (e.g., the application has not been abandoned). Given the fact that the related petition for the '061 Application was shown to deserve the accurate April 6, 2006 filing date by the USPTO, Applicants respectfully request that the present petition be granted for the same reason.

The additional evidence provided with this petition, and the evidence previously presented supports this conclusion. The correspondence delivered to Grosse Bockhorni & Schumacher ("GBS") on April 7, 2006, which came in to existence within one day of the filing of such application, is clearly corroborating evidence of the April 6, 2006 filing date as required by 37 CFR 1.10(d)(3). Applicants also direct the Office's attention to the Supplemental Declaration of Susan Willson, who personally confirmed the filing date of April 6, 2006 prior to signing the correspondence delivered the following day on April 7, 2006. The confirmation was made by reviewing the email of Carol Werner (Exhibit B) sent on April 6, 2006, and by speaking with Ms. Werner on April 7, 2006, prior to delivering the facsimile correspondence to GBS. The transmission report for the facsimile correspondence to GBS shows it was sent at 1:49 p.m. on April 7, 2006, confirming that the case was filed with the USPTO the previous day - April 6, 2006. This facsimile

was signed by Ms. Willson, an attorney licensed in Colorado for over 30 years, and the statements contained therein were verified by her speaking with Mr. Abeyta prior to conveyance of the confirmation facsimile to GBS.

This record was created within one day of the correct filing date of such application, and Applicants assert that this record therefore satisfies the third criterion requested by the USPTO. Applicants respectfully note that 37 CFR 1.10(d)(3) does not require absolute proof of mailing on the date in question - all that is required is evidence that came into being after deposit and within one business day of the filing. A log book is merely one example of how the criterion may be met with evidence of its reliability, however, it is not the only way to make a showing of corroborating evidence of the actual date of deposit. In the present application, the correspondence delivered to GBS coupled with the Supplemental Declaration of Ms. Willson leaves no question as to the accurate date of deposit, which was April 6, 2006.

Applicants also direct the Office's attention to the Supplemental Declaration of Ian Walsworth, an associate attorney with Sheridan Ross, P.C., who investigated this matter with the United States Postal Service. After discussing the failure of the USPS to properly record the Time Accepted for the Express Mailing receipt associated with this application, Mr. Walsworth was directed to Mr. Mark C. Lane (See Declaration of Ian Walsworth attached hereto). It is notable that to date no explanation has been provided as to why the Time Accepted was recorded correctly on some of the applications deposited on April 6, 2006, but not recorded at all on the present application's Express Mailing receipt. Furthermore, Mr. Lane confirmed that it is not necessarily the case, and there is no guarantee, that all Express Mail deposited prior to the last collection time for a given day would be recorded by a USPS employee on the day it was deposited. In conjunction with

the previous evidence submitted showing the peculiar fact that no time entry was entered on the Express Mailing receipt for the application at issue, it is suggestive that such application was not recorded accurately by the USPS when it was received on April 6, 2006. It is particularly suspicious that the April 7, 2006 USPS date has no time entry while the other applications retrieved from the USPS with a date-in of April 6, 2006 were recorded with an approximate time (with the exception of this application and the '061 Application).

With such new evidence, and in combination with the previously submitted petitions and exhibits thereto, Applicants respectfully request the favorable grant of the present petition. Applicants' counsel requests the courtesy of a telephone call at (303) 863-2977 in the event any further questions or concerns require further discussion or elucidation. No fees are believed to be owing, however, if such fees are due, please deduct them from Deposit Account No. 19-1970.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: _____

Joseph E. Kovarik
Registration No. 33,005
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

Date: _____

3/15/07

J:\2584\Sg-5\third renewed petition.wpd

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

KELLER et al.

Serial No.: 10/575,019

Filed: April 6, 2006

Atty. File No.: 2584SG-5

For: "INSULATING ELEMENT FROM
MINERAL FIBERS FOR SHIPBUILDING")

) SUPPLEMENTAL DECLARATION OF
) SUSAN WILLSON IN SUPPORT OF
) RENEWED PETITION PURSUANT TO 37
) C.F.R. 1.10(d)

| |
|--|
| <p style="text-align: center;">CERTIFICATE OF MAILING</p> <p>I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 ON <u>March 15, 2007</u></p> <p style="text-align: center;">SHERIDAN ROSS P.C.</p> <p>BY: <u>Brenda Carpenter</u></p> |
|--|

I hereby declare as follows:

1. I incorporate by reference my Declaration of November 14, 2006.
2. I have reviewed the Decision from the U.S. Patent and Trademark Office ("USPTO") dated December 6, 2006 with respect to this matter. I hereby declare that it is my custom and practice to confirm filing of documents with the USPTO by communicating with the staff members responsible for depositing accountable mail with the USPS. I declare that I communicated with Ms. Carol Werner regarding this application prior to the April 7, 2006 correspondence to the foreign associate counsel.
3. The application was deposited with other applications on April 6, 2006, including PCT/EP04/11061 which was initially given the incorrect date-in of April 7, 2006. Therefore the filing date of April 7, 2006 is in error.

Date: February 23, 2007

By: Susan P. Willson
Susan Willson, Esq.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

KELLER et al.

Serial No.: 10/575,019

Filed: April 6, 2006

Atty. File No.: 2584SG-5

For: "INSULATING ELEMENT FROM
MINERAL FIBERS FOR SHIPBUILDING")

) THIRD SUPPLEMENTAL DECLARATION
) OF EDDIE ABEYTA IN SUPPORT OF
) RENEWED PETITION PURSUANT TO 37
) C.F.R. 1.10(d)

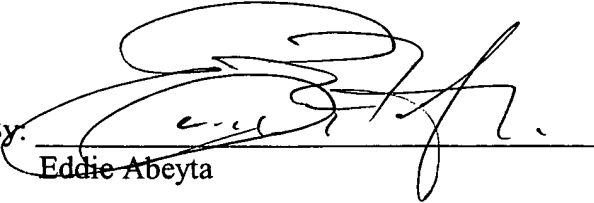
| |
|---|
| CERTIFICATE OF MAILING |
| I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 ON <u>March 15, 2007</u> |
| SHERIDAN ROSS P.C. |
| BY: <u>Bunda Carpenter</u> |

I hereby declare as follows:

1. I incorporate by reference my Declarations of June 6, 2006 and November 14, 2006.
2. I have reviewed the Decision from the U.S. Patent and Trademark Office ("USPTO") dated December 6, 2006 with respect to this matter. In compliance with the USPTO's request, the exhibits previously attached to my prior Declarations suffice to show the Express Mail number and the attorney docket number of the subject application. To establish that the national stage papers were deposited in Express Mail prior to the last scheduled pick-up on 4/6/06, I declare that as a matter of custom and routine, I hand deliver accountable mail documents to the USPS so that they are accorded a filing date on the date of such deposit. Also as a matter of custom and routine, I only deliver accountable mail once per day in the evening after 5:00p.m. and prior to the last scheduled mail pickup. This routine has been established by the Sheridan Ross, P.C. law firm to ensure that all documents to be deposited are provided to me at the close of the business day and in advance of the last scheduled pickup, and to eliminate multiple deposits with the USPS during a given day.
3. I personally deposited such documents on such date at or about 6:20p.m. and prior to the last scheduled pickup, according to the custom and routine as Sheridan Ross' designated administrator of patent filing correspondence. I further attest that on April 6, 2006, I personally delivered several other patent applications for delivery via express mail at or about 6:20p.m., and that at least one of these applications was for the particular client at issue here. I attest to the fact

that I followed the above described procedures for these other applications as well as the application which is the subject of the present petition, and that such other applications were provided with the correct filing date of April 6, 2006. The filing date of April 7, 2006 is in error.

Date: 3-9-07

By: 
Eddie Abeyta

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:) Group Art Unit:
)
KELLER et al.) Examiner:
)
Serial No.: 10/575,019) Confirmation No.:
)
Filed: April 6, 2006) SUPPLEMENTAL DECLARATION OF
) CAROL WERNER IN SUPPORT OF
Atty. File No.: 2584SG-5) RENEWED PETITION PURSUANT TO 37
) C.F.R. 1.10(d)
For: "FIRE PROTECTION GATE AND
CORRELATED FIRE PROTECTION
INSET"

I hereby Declare as follows:

1. I incorporate by reference my Declaration of June 6, 2006.
2. I assisted in preparing the above-referenced application, along with three other applications, during the weeks leading up to April 6, 2006. After completing these four applications for delivery via Express Mail, I personally delivered these applications, including the application of the present petition, to Mr. Abeyta, the Sheridan Ross, P.C. employee responsible for depositing the express mail with the USPS. I delivered these four completed applications to Mr. Abeyta prior to 5:00 p.m. on April 6, 2006.
3. At 5:23 p.m. on April 6, 2006, I sent an email correspondence to the foreign associate, Grosse Bockhorni & Schumacher ("GBS"), attached hereto as Exhibit B. In that email correspondence, I confirmed to GBS that the four applications were completed and filed via Express Mail. Identified in the subject line are the GBS file numbers, of which P85288US refers to the application of the present petition. The GBS file numbers P85294US and P85298US were subsequently accorded a April 6, 2006 deposit date, while the application of the present petition did not, despite being deposited together on April 6, 2006.
4. I included a copy of this email to Susan Willson, managing partner of foreign patent prosecution for Sheridan Ross, P.C., to inform her of the status of these four applications. In addition to this email correspondence with Ms. Willson, I further communicated with her in person on April 7, 2006 to confirm the filing of these four applications on April 6, 2006. I also assisted in drafting the facsimile correspondence to GBS which was delivered on April 7, 2006, a copy of which has been submitted in a previous petition.

Date: 12 March 2007

By: Carol Werner
Carol Werner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

KELLER et al.

Serial No.: 10/575,019

Filed: April 6, 2006

Atty. File No.: 2584SG-5

For: "FIRE PROTECTION GATE AND
CORRELATED FIRE PROTECTION
INSET"

) Group Art Unit:

)

) Examiner:

)

) Confirmation No.:

)

) DECLARATION OF IAN WALSWORTH

) IN SUPPORT OF RENEWED PETITION

) PURSUANT TO 37 C.F.R. 1.10(d)

)

I hereby Declare as follows:

1. I am an employee of the law firm of Sheridan Ross P.C., 1560 Broadway, Suite 1200, Denver, Colorado 80202. I have worked for Sheridan Ross as an associate attorney since October 4, 2006.

2. On March 2, 2007, I had a telephone conversation with Mr. Mark C. Lane, Expedited Service Specialist for the Colorado and Wyoming District regarding the Express Mail receipt for the application of the present petition. I explained to Mr. Lane that we had received two Express Mailing receipts which were given an incorrect deposit date, and in addition no time entry was recorded in the Time Accepted field for those Express Mailing receipts. Mr. Lane stated that Express Mail deposited in a drop box at a USPS location prior to the last collection time for that day should be recorded with the date and time for the day it was actually deposited in the drop box. Mr. Lane further stated that although this is the preferred practice for USPS locations with regard to receipt of Express Mail, there is no guarantee that all mail deposited in a drop box will be recorded with the exact time and date of deposit. Mr. Lane stated that the cut-off time for guaranteed next day delivery for Express Mail on April 6, 2006 was prior to 6:20 p.m., the time that Mr. Abeyta declared he deposited the application of the present petition.

Date: 3/12/2007

By: Ian R. Walsworth
Ian R. Walsworth, Esq.

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

SPW/JEL

| | | |
|-----------------------------|-----------------------|------------------|
| U.S. APPLICATION NUMBER NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 10/575,018 | Horst Keller | 2584SG-3 |

22442
 SHERIDAN ROSS PC
 1560 BROADWAY
 SUITE 1200
 DENVER, CO 80202

INTERNATIONAL APPLICATION NO.

PCT/EP04/11061

I.A. FILING DATE

10/04/2004

PRIORITY DATE

10/06/2003

RECEIVED

DEC 19 2006

SHERIDAN, ROSS

CONFIRMATION NO. 7058

371 FORMALITIES LETTER



OC000000021543125

Date Mailed: 12/12/2006

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 04/07/2006
- Copy of the International Search Report filed on 04/07/2006
- Preliminary Amendments filed on 04/07/2006
- Information Disclosure Statements filed on 04/07/2006
- Request for Immediate Examination filed on 04/07/2006
- U.S. Basic National Fees filed on 04/07/2006
- Priority Documents filed on 04/07/2006
- Specification filed on 04/07/2006
- Claims filed on 04/07/2006
- Abstracts filed on 04/07/2006
- Drawings filed on 04/07/2006

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.492(h) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.

SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$130** for a Large Entity:

- **\$130** Surcharge.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.
<https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

MAMIE P PERSON

Telephone: (703) 308-9140 EXT 227

PART 1 - ATTORNEY/APPLICANT COPY

| U.S. APPLICATION NUMBER NO. | INTERNATIONAL APPLICATION NO. | ATTY. DOCKET NO. |
|-----------------------------|-------------------------------|------------------|
| 10/575,018 | PCT/EP04/11061 | 2584SG-3 |

EXHIBIT B

Carol Werner

From: Carol Werner
Sent: Thursday, April 06, 2006 5:23 PM
To: 'ap@patguard.de'
Cc: Susan Willson
Subject: Your Ref Nos. P85294US, P85298US, P85288US, P85284US

Dear Mr. Bockhorni:

These applications have been filed today in the U.S. Patent Office. Our reporting letters will follow.

Sincerely,
Carol Werner

*Carol Werner
Assistant to Susan P. Willson, Esq.
Sheridan Ross P.C.
1560 Broadway, Suite 1200
Denver, Colorado 80202
303-863-9700 - Main
303-764-3022 - Direct
303-863-0223 - Fax
cwerner@sheridanross.com*

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4/6/2006